

5624/USSN 10/031,366
Group Art Unit 1753

REMARKS

Applicants have considered the outstanding official action. It is respectfully submitted that the claims are in condition for allowance as set forth below.

Applicants note that claims 4-6, 13, 14, 16, 31 and 32 are allowed. Claims 4-6, 13, 14 and 16 are in independent form. It is noted that claims 31 and 32 each depend on claim 30 which is in turn dependent on claim 14. Claim 30 is objected to under 37 CFR 1.75(c) on the basis that the limitation of claim 30 is inherently present in claim 14. Accordingly, since the subject matter of claim 30, and thus more specifically claims 31 and 32, are present within claim 14 and to insure the case is in condition for formal allowance, claims 31 and 32 are canceled in favor of claim 14. Accordingly, claims 4-6, 13, 14 and 16 are in condition for allowance. Formal allowance thereof is respectfully requested.

In view of the acceptance of the proposed corrected drawings filed November 8, 2004, corrected drawings labeled "Replacement Sheet" are attached hereto.

The informality in the specification noted by the Examiner has been corrected.

5624/USSN 10/031,366
Group Art Unit 1753

The outstanding objection and rejections are as follows:

- (1) Claims 30 and 33 under 37 CFR 1.75(c) as being in improper dependent form for failing to further limit the subject matter of the previous claim;
- (2) Claims 34 and 35 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description;
- (3) Claims 28, 29, 34 and 35 under 35 U.S.C. §112, second paragraph, as being indefinite;
- (4) Claims 1-3, 7-8, 10, 18, 21, 28 and 29 under 35 U.S.C. §102(b) as anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over WO 99/17883 (Tai);
- (5) Claims 1, 17, 18 and 28 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over WO 98/04355 (Pethig '355);
- (6) Claims 1, 18-21 and 28 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over "Electromanipulation and separation of cells using travelling

electric fields", J. Phys. D. Appl. Phys., vol.
29, pages 2198-2203 (1996) ("Talary");

- (7) Claims 1, 10-12, 18-25 and 28 under 35 U.S.C.
§102(b) as anticipated by or, in the alternative,
under 35 U.S.C. §103(a) as obvious over U.S.
Patent No. 5,858,192 (Becker);
- (8) Claims 1, 7-10, 18 and 28 under 35 U.S.C. §102(b)
as anticipated by or, in the alternative, under 35
U.S.C. §103(a) as obvious over WO 97/34689 (Pethig
'689);
- (9) Claims 1-3, 7-10, 17-26, 28 and 29 under 35 U.S.C.
§103(a) as being unpatentable over Tai;
- (10) Claims 1, 17-26 and 28 under 35 U.S.C. §103(a) as
being unpatentable over Pethig '355;
- (11) Claims 1, 17-26 and 28 under 35 U.S.C. §103(a) as
being unpatentable over Talary;
- (12) Claims 1, 10-12, 17-26 and 28 under 35 U.S.C.
§103(a) as being unpatentable over Becker; and
- (13) Claims 1, 7-10, 17-26 and 28 under 35 U.S.C.
§103(a) as being unpatentable over Pethig '689.

In order to place the application in condition for
formal allowance, claims 1-3, 7-12, 15 and 17-35 have been
canceled. The only pending claims are therefore allowed

5624/USSN 10/031,366
Group Art Unit 1753

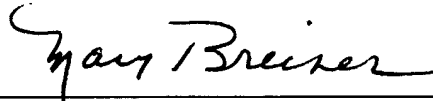
claims 4-6, 13, 14 and 16 and, thus, the above objection and rejections denoted as (1) to (13) are rendered moot.

Reconsideration and formal allowance of the application are respectfully urged.

Respectfully submitted,

GARY LOCK ET AL

By



Mary J. Breiner, Attorney
Registration No. 33,161
BREINER & BREINER, L.L.C.
P.O. Box 19290
Alexandria, Virginia 22320-0290

Telephone (703) 684-6885

Attachments - Corrected Figures 1 and 9b (2 Sheets)
- Application Data Sheet